



Paper No. 4

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INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS CO 80527-2400

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MAY 20 2002

OFFICE OF PETITIONS

In re Application of :
Movaghar, del Rosario, Diel, and :
Schmeling :
Application No. 09/982,327 : DECISION REFUSING STATUS
Filed: 17 October, 2001 : UNDER 37 CFR 1.47(a)
Attorney Docket No. 10960502-8 :

This is in response to the communication captioned "Statement of Facts Regarding Non-Signing Inventor)" filed on 21 February, 2002, which is being treated as a petition under 37 CFR 1.47(a).

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.
Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified reissue application was filed on 17 October, 2001, with a declaration naming Abdolreza Movaghar, Josephine del Rosario, Mark Diel, and David J. Schmeling as joint inventors and signed by all of the joint inventors except Diel on behalf of themselves and joint inventor Diel.

Accordingly, on 29 November, 2001, Initial Patent Examination Division mailed a Notice to File Missing Parts of Reissue Application, requiring an oath or declaration with the signature of inventor Diel and a surcharge for its late filing. A two (2) month period for reply was set.

In response, on 21 February, 2002 (certificate of mailing date 29 January, 2002), petitioners filed the present petition, accompanied by authorization to charge the petition fee.

Petitioners state that a copy of the application papers were sent to joint inventor Diel, but were returned as undeliverable.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

- (3) the petition fee;

- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

- (5) a statement of the last known address of the non-signing inventor.

The petition lacks items (1), (2), and (5).

In regards to item (1), petitioners have not shown that diligent efforts were made to locate the non-signing inventor.¹ At the outset, the petition states that petitioners' "received a call stating that Mark [Diel] has not lived at this address for at least the past four years." Petitioners have not shown that any efforts were made to obtain a more recent address. A brief Internet search reveals that Diel may now be residing in Menlo Park, CA. Petitioners should show that diligent efforts were made to give or send a copy of the application papers (specification, claims, drawings, if any, and the declaration) at the inventor's last known address. Petitioners should submit a copy of the cover letter transmitting the application papers to the nonsigning inventor at the last known address or, if presented in hand affidavits or declarations of facts by a person having first-hand knowledge of the details thereof.

¹MPEP 409.03(d).

If the envelope sent to the non-signing inventor at the last known address is returned as undeliverable by the post office, petitioners should provide a copy of the envelope showing that the application was returned as undeliverable with any renewed petition. If the inventor refuses in writing to sign, a copy of that written refusal should be provided with any renewed petition. If the inventor refuses orally, petitioners should submit details of the refusal in an affidavit or declaration of facts by a person having first-hand knowledge of the refusal.

If repeated attempts to contact the non-signing inventor are unsuccessful, petitioners will have shown that despite diligent efforts, the inventor could not be reached.

In regards to item (2), the declaration contains is defective in that it contains non initialed and/or non-dated alterations.² Specifically, there is an uninitialed and/or undated alteration in the signature block for joint inventor Schmeling. A new oath or declaration in compliance with 37 CFR 1.63 and 1.67, signed by the inventor to whom the error or deficiency relates is required.³

In regards to item (5), if a more recent last known address is discovered for the last known address, that address must be provided with any renewed petition.

The petition fee of \$130.00 has been charged to counsel's deposit account, No. 08-2025, as authorized on the transmittal letter accompanying the petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
 Box DAC
 Washington, D.C. 20231

By FAX: (703) 308-6916
 Attn: Office of Petitions

²See 37 CFR 1.52(c).

³37 CFR 1.67(a)(2).

By hand: Crystal Plaza Four, Suite 3C23
 2201 S. Clark Place
 Arlington, VA

Telephone inquiries related to this decision should be directed
to the undersigned at 703-308-6918.



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Office of the Deputy Commissioner
for Patent Examination Policy